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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/730,585	12/08/2003	Pavel Novak	02931-P0064A	4550
24126	7590	02/03/2006		
ST. ONGE STEWARD JOHNSTON & REENS, LLC			EXAMINER	
986 BEDFORD STREET			PEFFLEY, MICHAEL F	
STAMFORD, CT 06905-5619			ART UNIT	PAPER NUMBER
			3739	

DATE MAILED: 02/03/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/730,585

Applicant(s)

NOVAK, PAVEL

Examiner

Michael Peffley

Art Unit

3739

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 December 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-17 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 08 December 2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 5/12/04.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

Drawings

Figure 2 should be designated by a legend such as --Prior Art-- because only that which is old is illustrated. See MPEP § 608.02(g). Corrected drawings in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Objections

Claim 12 is objected to because of the following informalities: "stat" in line 2 should be "state". Appropriate correction is required.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-9 and 12-17 are rejected under 35 U.S.C. 102(b) as being anticipated by Newton (4,827,927).

Newton discloses an electrosurgical device that includes an HF generator (10) that has at least three operating states (cut, coag, cut/coag) with first, second and third switches (28,30,32, 36, 38) assigned to the operating states and at least one control line (24,26) coupling the switches to the generator (see Figure 2). Each switch operates to code a particular mode, and a third mode (i.e. cut/coag down) operates by the simultaneous closing of first and second switches (col. 3, lines 14-20). The switches are connected in parallel.

Claims 1-3, 5-7, 9-12, 14, 15 and 17 are rejected under 35 U.S.C. 102(b) as being anticipated by German Publication Number 2,429,021.

As seen in Figure 2, the DE Publication provides a device comprising an HF generator with three modes of operation, and first, second and third switches (19,20,21) for activating those states. The switch arrangement in the '021 publication is substantially identical to applicant's disclosed invention except that the third switch (19) comprises a direct connect line (22) instead of a parallel diode circuit or a combined closing of the first and second switches as disclosed in the instant application. The switches are "coded" using diodes (23,24) and the switches are connected in parallel.

Claims 1-3, 5-7, 9, 12, 14, 15 and 17 are rejected under 35 U.S.C. 102(e) as being anticipated by Ellman et al (6,652,514).

Applicant cannot rely upon the foreign priority papers to overcome this rejection because a translation of said papers has not been made of record in accordance with 37 CFR 1.55. See MPEP § 201.15.

As seen in Figures 8 and 9, Ellman et al provide a surgical system that includes a HF generator connected to a handpiece, the handpiece having three or more switches coded to control the mode of the generator. The switches are connected in parallel and have output signals being fed to the generator via at least one control line (Figure 9).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 4, 6, 8, 13 and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ellman et al ('514) in view of the teaching of Newton ('927).

The Ellman et al device has been addressed above. Ellman et al disclose at least three switches on an electrosurgical handpiece with a means to code the switch signal to control the mode of the generator. However, Ellman et al fail to specifically disclose an embodiment whereby the pressing of a button (i.e. the third button) simultaneously closes the other two buttons as set forth in these claims. Rather, Ellman et al provide a different resistance value for each signal from a depressed switch.

Newton, also addressed previously, disclose a plurality of switches on a handpiece to control the output of a generator, and specifically teach that it is known to

activate two switches simultaneously to act as a separate code for controlling the output of a generator.

To have provided the Ellman et al system with a switch activation that includes combining the outputs of two separate switches to provide a distinct signal code to control the output of a generator would have been an obvious consideration for one of ordinary skill in the art in view of the teaching of Newton.

Claims 10 and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over either Newton ('927) or Ellman et al ('514) in view of the teaching of German Publication Number 2,429,021.

As addressed previously, Ellman et al utilize resistors to provide uniquely coded signals upon the activation of a switch, and fail to teach the use of a diode to create the signal code. Newton utilizes different switch configurations to code a switch signal to control the output of a generator.

The German Publication discloses an analogous device and specifically teaches that it is known to use diodes to provide a unique signal code to control the output of a generator.

To have provided the Ellman et al system or the Newton system with diodes for creating a unique signal code, in lieu of the resistors or switch configuration, respectively, would have been an obvious design expedient for one of ordinary skill in the art, particularly since the German Publication teaches that it is known to use diodes to create signal codes to control the output of a HF generator.

Claims 4, 6, 8, 13 and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over German Publication Number 2,429,021 in view of the teaching of Newton ('927).

The German Publication has been addressed above. This publication discloses at least three switches on an electrosurgical handpiece with a means to code the switch signal to control the mode of the generator. Diodes are used to code the switch signals, which signals are used to control the output mode of the generator. However, the German Publication fails to specifically disclose an embodiment whereby the pressing of a button (i.e. the third button) simultaneously closes the other two buttons as set forth in these claims. Rather, the German Publication provides a third signal line (22) that has no components for coding the signal.

Newton, also addressed previously, disclose a plurality of switches on a handpiece to control the output of a generator, and specifically teach that it is known to activate two switches simultaneously to act as a separate code for controlling the output of a generator.

To have provided the German Publication system with a switch activation that includes combining the outputs of two separate switches to provide a distinct signal code to control the output of a generator would have been an obvious consideration for one of ordinary skill in the art in view of the teaching of Newton.

Conclusion

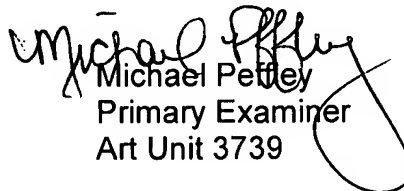
The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Ikuno et al (4,154,240), Garito et al (4,463,759), Harris (4,188,927), Hagiwara (4,398,534) and Sullivan (6,197,024) all disclose various electrosurgical devices with 3 or more switches for controlling the output of a HF generator.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael Peffley whose telephone number is (571) 272-4770. The examiner can normally be reached on Mon-Fri from 6am-3pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Linda Dvorak can be reached on (571) 272-4764. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Michael Peffley
Primary Examiner
Art Unit 3739

mp
January 30, 2006